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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,197	10/20/2000	Hideaki Yamanaka	198480US2	5849

22850 7590 10/06/2003

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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/692,197

Applicant(s)

YAMANAKA ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/692,197.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/692,197, filed on 10/20/2000. It has been placed in the application file, but the information referred to therein has not been considered because it does not contain an English translation in order to determine applicability. In that regard and for examination purposes, the priority date for the application will be considered to be 10/20/2000.

### ***Information Disclosure Statement***

The information disclosure statement filed 10/20/2000 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7, 9 –13 and remaining dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, a system claim for example, the applicant in the preamble uses “comprising the steps of”, which connotes a method claim. In that regard, claim 1 and dependent claims are consider to be indefinite. However, the claims will be treated as definite for examination purposes.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 9 and 11 - 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard (US 5,918,213) in view of Reisman (US 6,594,696 B1).

Regarding claim 1, the combination of Bernard and Reisman teach a digital content downloading system using a network in which digital content is downloaded, comprising the steps of: where Bernard teaches making a consumer send both information designating a desired digital content selected by the consumer (see at least Abstract and Figure 25). Regarding claim 8, Bernard teaches a digital content downloading system using a network, wherein the step of making the digital content retailer download the desired digital content includes: connecting the consumer to the network through a subscriber line which is composed of a telephone line, an optical fiber cable, a coaxial cable or a radio transmission line (see at least Abstract and Figures 4 – 8) and regarding claim 11, Bernard teaches a digital content downloading system using a network, wherein the step of making the consumer send both the information and the making the consumer send personal information and payment information of the consumer to the digital content retailer (Col 10, lines 44 – 45 and Figure 12);

making the digital content retailer inquire of a credit company whether or not the personal information and the payment information sent from the consumer is correct (Col 10, lines 44 – 45); making the credit company perform the authentication of the consumer according to the personal information and the payment information (Col 10, lines 44 – 45); and making the credit company send an authentication notice to the digital content retailer in cases where the personal information and the payment information is correct (Col 10, lines 61 - 67). Please note that Bernard does not specifically address each step such as authentication by the credit card company.

However, these steps are implicit and were old and well known for online shopping sites (see Chelliah (US 5,710,887). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the system of Bernard with these capabilities to ensure credit worthiness of shoppers – before consummating the sale. In addition and regarding claim 12, Bernard teaches a digital content downloading system using a network, wherein the step of making the digital content retailer collect a charge for the desired digital content includes: making the digital content retailer send an accounting notice corresponding to the charge for the desired digital content to a credit company; making the credit company send a bill, which corresponds to the charge for the desired digital content, to the consumer in response to the accounting notice; making the consumer pay the charge for the desired digital content to the credit company in response to the bill; and making the credit company pay the charge paid by the consumer to the digital content retailer (Col 2, lines 11- 12). Please note that the steps required to implement a credit approval and billing system were old and well

known at the time of the applicant's invention. Therefore, it would have been obvious to provide a credit approval and billing system in order to ensure payment. Regarding claim 14, Bernard teaches a digital content downloading system using a network, wherein the desired digital content is a music file, a video file or a game software title (Figure 28).

However, Bernard does not specifically disclose and teach a desired digital content transmission condition selected by the consumer to a digital content retailer possessing the desired digital content through a network; making the digital content retailer reserve the network managed by a network operator according to the desired digital content transmission condition sent from the consumer; making the digital content retailer download the desired digital content designated by the information to the consumer through the network reserved by the digital content retailer at the desired digital content transmission condition/sent from the consumer; making the digital content retailer collect a charge for the desired digital content, in which a transmission charge corresponding to the desired digital content transmission condition is included, from the consumer; and making the digital content retailer pay the transmission charge to the network operator.

On the other hand, Reisman teaches a desired digital content transmission condition selected by the consumer to a digital content retailer possessing the desired digital content through a network (see at least Abstract and Figure 1); making the digital

content retailer reserve the network managed by a network operator according to the desired digital content transmission condition sent from the consumer (see at least Col 25, lines 1 – 53); making the digital content retailer download the desired digital content designated by the information to the consumer through the network reserved by the digital content retailer at the desired digital content transmission condition/sent from the consumer (see at least Col 55, lines 19 – 26); making the digital content retailer collect a charge for the desired digital content, in which a transmission charge corresponding to the desired digital content transmission condition is included, from the consumer (see at least Col 60, lines 6 – 32); and making the digital content retailer pay the transmission charge to the network operator (see at least Col 60, lines 33 – 39). Moreover:

regarding claim 2, Reisman teaches a digital content downloading system using a network, wherein the desired digital content transmission condition selected by the consumer is a transmission time condition such as an urgent transmission condition, a date and time specifying transmission condition or a date specifying transmission condition (Col 16, lines 44 – 48).

regarding claim 3, Reisman teaches a digital content downloading system using a network, wherein the network is composed of a plurality of networks managed by a plurality of network operators, and the desired digital content transmission condition selected by the consumer corresponds to a communication quality of each of the networks (Col 4, lines 43 – 67) and (4) wherein the communication quality of each



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network is determined by one of a data transfer rate, a delay time, a delay variation, a burst size, a cell interval and a cell discard rate (Col 4, lines 43 - 67, Col 6, lines 60 - 67 and Col 7, lines 1 - 3) as well as (5) wherein a bandwidth of the network is reserved with a time condition in the network reservation according to the desired digital content transmission condition (Col 16, lines 44 - 45).

regarding claim 6, Reisman teaches a digital content downloading system using a network, wherein the desired digital content transmission condition selected by the consumer is a bandwidth guarantee type transmission condition, in which a transmission time period is guaranteed (Col 16, lines 44 - 45 and Col 19, lines 35 - 39), or a bandwidth no-guarantee type transmission conditions, in which a transmission time period is not guaranteed, and the transmission charge is heightened as the transmission time period is shortened.

regarding claim 7, Reisman teaches a digital content downloading system using a network, wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer check through the network whether or not the consumer has a capability such as a memory capacity for receiving the desired digital content, before the desired digital content is downloaded to the consumer at the desired digital content transmission condition (Col 16, lines 28 - 29) .

regarding claim 9, Reisman teaches a digital content downloading system using a network, wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer send a transmission start notice to the consumer before the downloading of the desired digital content; making the network operator manage a transmission time period in the transmission of the desired digital content until the digital content retailer sends a transmission completion notice to the network operator; making the network operator send a time-out notice to the digital content retailer in cases where the transmission time period exceeds a prescribed value; and making the digital content retailer forcibly terminate the downloading of the desired digital content in cases where the digital content retailer receives the time-out notice from the network operator (see at least Abstract and Col 16, lines 1 – 67).

regarding claim 13, Reisman teaches a digital content downloading system using a network, wherein the step of making the digital content retailer download the desired digital content includes: making the consumer send a reception impossible notice to the digital content retailer in cases where the consumer fails in receiving the desired digital content; making the digital content retailer send a transmission termination notice to the network operator; and making the digital content retailer send a transmission no-completion notice to the consumer (see at least Col 16, lines 23 – 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the system of Bernard with the system of Reisman to have enabled a digital content downloading system using a network in which digital content is downloaded, comprising the steps of: making a consumer send both information designating a desired digital content selected by the consumer and a desired digital content transmission condition selected by the consumer to a digital content retailer possessing the desired digital content through a network; making the digital content retailer reserve the network managed by a network operator according to the desired digital content transmission condition sent from the consumer; making the digital content retailer download the desired digital content designated by the information to the consumer through the network reserved by the digital content retailer at the desired digital content transmission condition/sent from the consumer; making the digital content retailer collect a charge for the desired digital content, in which a transmission charge corresponding to the desired digital content transmission condition is included, from the consumer; and making the digital content retailer pay the transmission charge to the network operator – in order provide the capability for a consumer regardless of communications networks to order and obtain digital content . In this manner, the consumer is relieved of all the old needs to establish the correct network connections for digital content and thereby will increase their satisfaction. With this increased satisfaction, the probability that they will return for additional ordering as well recommending the system to others.

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bernard and Reisman as applied to claim 1 above, and further in view of Spagna (US 6,587,837 B1).**

The combination of Bernard and Reisman substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach a digital content downloading system using a network wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer cipher the desired digital content; making the digital content retailer download ciphered data of the desired digital content; and making the consumer decipher the ciphered data of the desired digital content to obtain the desired digital content.

Regarding claim 10, Spagna teaches a digital content downloading system using a network wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer cipher the desired digital content; making the digital content retailer download ciphered data of the desired digital content; and making the consumer decipher the ciphered data of the desired digital content to obtain the desired digital content (see at least Col 3, lines 27 – 29 and Figures 1A – C).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Bernard and Reisman with the system of Spagna to enable a digital content downloading system using a network wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer cipher the desired digital content; making the digital content retailer download ciphered data of the desired digital content; and making the consumer decipher the ciphered data of the desired digital content to obtain the desired digital content – in order to ensure secure transmission of the digital content, which often contains proprietary information. In this manner, the sender and receiver of the digital content will be assured that only the desired recipient will be able to decrypt the information and thereby protect the digital contents from unauthorized use.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is "Integrated services over unified switching: Understanding Sprint ION"; Marty Kaplan; Computer Technology Review; Los Angeles; May 1999, Vol. 19, Iss, 5; pg. 18, 3pgs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm. If attempts to reach

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the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including  
After Final communications labeled  
"Box AF"]

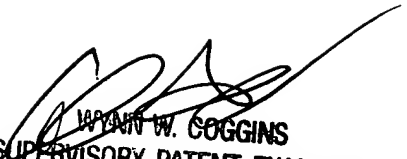
(703) 746-7206 [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER

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